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OFFICE OF PETITIONS

In re Application of :
Zigmund et al. : DECISION ON PETITION
Application No. 10/782,678 :
Filed: February 19, 2004 :
Atty Docket No. 306815.01 :

This is a decision on the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a) filed August 25, 2011.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)," as appropriate. Extensions of time under § 1.136(a) are permitted

The above-identified application became abandoned for failure to timely file a response to the Second Examiner's Answer dated December 9, 2008. Petitioner states that applicants never received the Examiner's Answer and thus, the entire delay in filing the reply brief was unavoidable. The petition includes a reply brief and payment of the petition fee. No terminal disclaimer is required.

A review of Office records confirms the alleged irregularity in the mailing of the Examiner's Answer mailed December 9, 2008 in this application. The returned Office action addressed to the correspondence address of record was returned on December 17, 2008.

However, the instant petition under 37 CFR 1.137(a) was not filed until almost three years after the original Office action was mailed and returned to the Office.

Pursuant to 35 U.S.C. 133 and 151, which allow for the revival of applications based on unavoidable delay, 37 CFR 1.137(a) provides that:

If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550 (d) or 1.957 (b) or limited under § 1.957 (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(1);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Requirement 3 is at issue. 35 U.S.C. 133 and 151 each require a showing that the "delay" was "unavoidable," which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing of a petition to revive. See In re Application of Takao, 17 USPQ2d 1155 (Comm'r Pat. 1990). The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. *Id.* at 1158. Thus, an applicant seeking to revive an "unavoidably" abandoned application must cause a petition under 37 CFR 1.137(a) to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application).

The Office does not generally question whether there has been an intentional or otherwise impermissible delay in filing an initial petition pursuant to 37 CFR 1.137(a) or (b), when such petition is filed: (A) within 3 months of the date the applicant

is first notified that the application is abandoned; and (2) within 1 year of the date of abandonment of the application. Thus, an applicant seeking revival of an abandoned application is advised to file a petition pursuant to 37 CFR 1.137 within 3 months of the first notification that the application is abandoned to avoid the question of intentional delay being raised by the Office (or by third parties seeking to challenge any patent issuing from the application). Where a petition pursuant to 37 CFR 1.137(a) or (b) is not filed within 3 months of the date the applicant is first notified that the application is abandoned, the Office may consider there to be a question as to whether the delay was unavoidable or unintentional. In such instances,

(A) the Office will require a showing as to how the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(a) petition was filed was "unavoidable"; or

(B) the Office may require further information as to the cause of the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(b) petition was filed, and how such delay was "unintentional."

As the instant petition pursuant to 37 CFR 1.137(a) was not filed within 1 year of the date of abandonment of the application (note that abandonment takes place by operation of law, rather than by the mailing of a Notice of Abandonment) the Office is requiring: (A) further information as to when the applicant (or applicant's representative) first became aware of the abandonment of the application; and (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant's representative) (see Pratt, 1887 Dec. Comm'r Pat. at 32-33).

Applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application.

CONCLUSION

While petitioner has not met the requirements for revival under 37 CFR 1.137(a), petitioner is not precluded from obtaining

relief by filing a petition based on unintentional delay, pursuant to 37 CFR 1.137(b).

Petitioner should not delay filing a petition pursuant to 37 CFR 1.137(b) (or a renewed petition under 37 CFR 1.137(a)) as applicant bears the burden of establishing that the entire delay, including the delay from the due date for the reply until the filing of a grantable petition, was unintentional (or unavoidable).

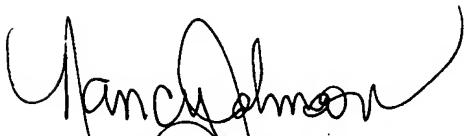
Further correspondence with respect to this decision should be addressed as follows:

By mail: Mail Stop Petition
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By fax: (571) 273-8300
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By hand: Customer Service Window
 Randolph Building
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Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized loop at the end.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions